

REMARKS

Claim 1 has been amended based on, e.g., the disclosure at page 4, lines 14-15 and page 14, lines 9-10 and the working examples in the application. Also, claims 1-3 and 5 have been amended to correct typographical errors which occurred in the Preliminary Amendment filed September 19, 2005 (a period after "hard coat layer" in claim 1, a molecular weight of 200 rather than 2000 in claim 2, a dash after "2" in the range of 2 to 30 micrometers in claim 3, and a period at the end of claim 5).

Entry of the above amendment is respectfully requested.

Rejection under 35 U.S.C. 112, First Paragraph

On page 2 of the Office Action, in paragraph 2, claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling.

The Examiner's Position

The Examiner indicates that the present specification appears to teach that using the claimed pressure sensitive adhesive sheet gives a resulting improvement in such properties as scratch, water and chemical resistance, to the surface of image papers as well as improved definition of an image paper, and also reduction in the thickness of the pressure sensitive adhesive layer. The Examiner believes that all of these properties are critical or essential elements in the practice of the invention, but are not included in the claims. Thus, the Examiner asserts that the claims are thus not enabled by the disclosure, citing *In re Mayhew*, 527 F.2d

1229, 188 USPQ 356 (CCPA 1976). The Examiner suggests that such apparently nonobvious properties be put into the independent claim preambles.

Applicant's Response

In response, Applicant notes initially that the *Mayhew* case cited by the Examiner stands for the proposition that a feature which is taught as critical in a specification and is not recited in the claims should result in a rejection of such claim under the enablement provision section of 35 U.S.C. 112 (see MPEP 2164.08(c)), and that a claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling (see MPEP 2172.01). As set forth in MPEP 2172.01, such essential matter may include missing elements, steps or necessary structural cooperative relationships of elements described by the applicant as necessary to practice the invention.

However, Applicant submits that the properties mentioned by the Examiner are not elements of the claimed pressure sensitive adhesive sheet or structural cooperative relationships of elements of the claimed pressure sensitive adhesive sheet, nor are they steps of the claimed method for producing a pressure sensitive adhesive sheet. Rather, they are simply properties improved by the claimed structure. That is, the improved properties provided by the claimed structure are benefits resulting from the claimed structure, and are not part of the claimed structure (or the claimed method) itself. Accordingly, Applicants submits that it is not necessary to include these properties in the claims, and that the specification enables one skilled in the art

to make and use the pressure sensitive adhesive sheet and the method of producing that sheet as presently claimed. Thus, withdrawal of this rejection is respectfully requested.

Art Rejection over Tsuchiya et al '041 (Tsuchiya '440 is Cumulative)

On page 3 of the Office Action, in paragraph 5, claims 1 and 2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tsuchiya et al '041 (Tsuchiya '440 is cumulative).

The Examiner's Position

The Examiner's position is basically that the reference discloses a hard coat film which can comprise, in order, hard coat layer 3, buffer layer 2 (which can be an ionizing radiation curing resin which is most preferably a urethane acrylate resin), and an adjacent plastic film 1 which can be cured and may be coated on its opposite side with adhesive layer 4. Although the adhesive layer is not specifically taught as being pressure sensitive, the Examiner believes this property is believed to be either inherent or at most an obvious modification to one of ordinary skill in the art.

Applicant's Response

In response, Applicant notes initially that the present application indicates at page 2, lines 9-15 that conventional pressure sensitive adhesive sheets for protecting a surface have an adhesive layer formed on a substrate film, and that such conventional pressure sensitive adhesive sheets have a problem visibility decreases due to distortion.

As can be seen from the description of the reference by the Examiner himself, the reference discloses a hard coat film which can comprise, in order, hard coat layer 3, buffer layer 2 (which can be cured urethane acrylate), and an adjacent plastic film 1 which can be cured and may be coated on its opposite side with adhesive layer 4. Thus, a plastic film is present in the reference, and **the adhesive layer is in contact with the plastic film in the reference, not with a cured urethane acrylate layer.** In this regard, the reference appears to correspond to the conventional pressure sensitive adhesive sheets disclosed on page 2 in the present application.

In contrast, claim 1 has been amended to further clarify that the present invention requires a pressure sensitive adhesive layer, a cured urethane (meth)acrylate layer, and a hard coat layer, wherein the layers are laminated in order, and wherein the adhesive layer is in contact with the cured urethane (meth)acrylate layer. Thus, **in the present invention, the adhesive layer is in contact with the cured urethane (meth)acrylate layer.**

Further, Applicant submits that in the present specification, comparative example 1 is directed to a pressure sensitive adhesive sheet comprising, in order, a hard coat layer, a polyethylene terephthalate film and an acrylic pressure sensitive adhesive layer. As can be seen from the results set forth in Table 1 on page 23 in the present specification, comparative example 1 is inferior in bending resistance and visual definition of image as compared with the present invention. In this regard, Applicant notes that while comparative example 1 does not comprise a cured urethane (meth)acrylate layer and in this point is different from Tsuchiya et al '041, comparative example 1 is the same as Tsuchiya et al '041 in comprising a plastic film. Thus,

Applicant submits that the present invention is also not obvious because it provides unexpected results over an embodiment in which a plastic film is present, such as Tsuchiya et al '041.

In view of all the above, Applicant submits that the present invention is neither anticipated by nor obvious over the cited art, and withdrawal of this rejection is respectfully requested.

Obviousness Rejection over Tsuchiya et al '440

On page 3 of the Office Action, in paragraph 6, claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya et al '440.

The Examiner's Position

The Examiner's position is that elements of the sheet such as layer thickness and the presence of a filler are, if not expressly disclosed in the reference, obvious modifications to one of ordinary skill, in the absence of unexpected results. As to method claim 5, the Examiner believes that the reference teaches that almost any conventional laminating and related methods are suitable for forming the claimed genus of articles.

Applicant's Response

With respect to product claims 3 and 4, Applicant submits that the reference does not even teach or suggest the invention of present claim 1 as discussed above, so claims 3 and 4, which depend from claim 1, are not obvious for at least this reason.

As to method claim 5, Applicant wishes to point out that it recites a step of forming a pressure sensitive adhesive layer on an exposed surface of a cured urethane (meth)acrylate layer.

In contrast, as noted above, the reference discloses a hard coat film which can comprise, in order, hard coat layer 3, buffer layer 2 (which can be cured urethane acrylate), and an adjacent plastic film 1 which can be cured and may be coated on its opposite side with adhesive layer 4. Thus, the reference would use a method which involves forming an adhesive layer on its plastic film, not a method which involves forming an adhesive layer on cured urethane acrylate.

Accordingly, the reference does not teach or suggest the step of forming a pressure sensitive adhesive layer on an exposed surface of a cured urethane (meth)acrylate layer as in the present invention.

Further, Applicant submits that the reference does not teach or suggest the step of applying urethane (meth)acrylate on a surface of a releasing agent layer as in the present method, since the urethane acrylate in the reference is coated on the plastic film on which it remains in the final product of the reference.

Also, Applicant submits that the reference does not teach or suggest the step of laminating a process film on a surface of the hard coat layer as in the present method, since the reference does not need to peel its hard coat layer/urethane acrylate layer structure from a releasing agent layer as is done in the present method to provide an exposed surface of a urethane (meth)acrylate layer on which pressure sensitive adhesive is coated as in the present method.

Accordingly, Applicant submits that the present invention is not obvious over the cited reference, and withdrawal of this rejection is respectfully requested.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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